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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,446	11/10/2003	Raymond F. Horvath	UDL-004D2 (9424/6)	4873
48425	7590	11/30/2005	EXAMINER	
LAWSON & WEITZEN, LLP 88 BLACK FALCON AVE SUITE 345 BOSTON, MA 02210			HABTE, KAHSA Y	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/705,446

Applicant(s)

HORVATH ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 76 is/are pending in the application.
- 4a) Of the above claim(s) 76 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1 and 76 are pending in this application.
2. It is recommended that applicants delete claim 76 that is drawn to non-elected invention.

### ***Response to Amendment***

3. Applicant's amendment filed 10/12/05 in response to the previous Office Action (07/29/2005) is acknowledged. Rejection of claim 1 under 35 U.S.C. § 112, second paragraph (items 7a-7b) has been obviated.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: the term "Formula" is written in singular form instead of plural form. It is recommended that the term "Formula" read as "Formulae".

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1624

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. In claim 1, there is definitions for variables  $R^{14}$ , but said variable is not part of any of the core structures shown as Formulae II, IV, V, VII-IX and XI or is not recited in the definitions of other variables such as  $R^1$ - $R^5$ . Note that the definition  $X = CR^{14}$  has been amended to C (carbon).

b. In claim 1, the phrase "B and  $R^2$  jointly...optionally substituted at each position with  $R^7$ " is incorrect. The substitution can only be at the carbons not at each position i.e. oxygen or sulfur can only make two bonds and the substitution of  $R^7$  is not allowed. Note that issue was raised previously for A and  $R^2$  jointly...optionally substituted at each position with  $R^7$  and applicants fixed the problem, but not for B and  $R^2$ .

c. In claim 1 (page 8, lines 4-5 and lines 20-21) the phrase "with the proviso that 2 adjacent substituents can optionally form together a  $C_3$ - $C_{10}$  cycloalkyl ring" is not clear. What adjacent substituents? Is it referring to alkyl substituents? If so, the adjacent substituents have to be limited to alkyl substituents.

Likewise, said phrase is confusing because of the proviso. Why need for a proviso when only adjacent substituents optionally form together a  $C_3$ - $C_{10}$  cycloalkyl?

Art Unit: 1624

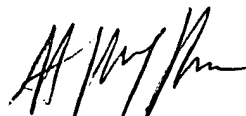
Note that formation of the cycloalkyl ring is optional and is formed by alkyl substituents only.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (571) 272-0667. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kahsay Habte, Ph. D.  
Examiner  
Art Unit 1624

KH  
November 28, 2005